REMARKS

In accordance with the foregoing, claim 11 is amended. Claim 22 is cancelled. No new matter is added. Claims 11, 14-15, 17 and 20-21 are pending and under consideration.

This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding.

Entry of Amendment under 37 C.F.R. § 1.116

The Applicant requests entry of this Rule 116 Response because the amendment does not significantly alter the scope of the claims and places the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures (M.P.E.P.) sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The M.P.E.P. further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

The Examiner is kindly reminded that this amendment is being filed within two months from the mailing date of the final Office Action, which was mailed on July 7, 2009.

CLAIM OBJECTIONS AND REJECTIONS UNDER 35 U.S.C. §112

Claim 22 is objected to and rejected under 35 U.S.C. §112, first and second paragraphs. Claim 22 is cancelled herewith, which renders the objection and rejection moot.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claims 11, 14-15, 17, and 20-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0009659 to DiSanto et al. (hereinafter "DiSanto") in view of the article "*Conversational IP multimedia Security*" by Blom et al. ("Blom").

Independent claim 11 has been amended to recite:

> a protocol processing unit processing data packets transported on the packet-oriented network using the encrypted transport protocol with keys for the encrypted transport protocol exchanged using a

key exchange protocol, converting voice signals, created by the one of the first and second telecommunication terminals at which said security module is connected, into data packets for transport via the encrypted transport protocol and converting data packets, arriving at said security module after transport via the encrypted transport protocol, into voice signals;

a modem connection unit, used when said security module is connected in a connecting line at a second telecommunication terminal, setting up a modem connection between the second telecommunication terminal and at least one of a gateway and another second telecommunication terminal, with the data packets being transported using the encrypted transport protocol, along with messages of the key exchange protocol, via the modem connection, wherein

a point-to-point protocol connection is used over the modem connection in transporting the data packets using the encrypted transport protocol, as well as messages of the key exchange protocol, and

the encrypted transport protocol is Secure Real Time Transport Protocol.

As such, claim 11 provides a protocol processing unit that processes data packets transported on the packet-oriented network using the encrypted transport protocol with keys for the encrypted transport protocol exchanged using a key exchange protocol. Furthermore, claim 11 includes a modem connection unit, used when the security module is connected in a connecting line at a second telecommunication terminal, that transports the data packets using the encrypted transport protocol, along with messages of the key exchange protocol, via the modem connection. As such, the security module of claim 11 provides for end-to-end encryption between a client in a packet-oriented network and a client in a TDM (analog or digital) using the key exchange protocol and the encrypted transport protocol (SRTP) because each of the two distinct networks individually use the key exchange protocol and the encrypted transport protocol via the claimed protocol processing unit and modem connection unit, respectively. These features are not taught by either DiSanto or Blom.

Furthermore, the modem of DiSanto does not correspond to the claimed modem connection unit, as indicated by the Examiner. As discussed above, the claimed modem connection unit when the security module is connected in a connecting line at a second (TDM) telecommunication terminal for transporting the data packets using the encrypted transport protocol, along with messages of the key exchange protocol, via the modem connection. As such, the claimed modem connection unit provides a transfer of encrypted communications from the packet-oriented network into the TDM network because the packet-oriented network also uses the encrypted transport protocol with keys for the encrypted transport protocol exchanged

using the key exchange protocol.

DiSanto merely discloses a security device for secure communication over a plurality of networks (see DiSanto's Abstract). The internal modem 240 in FIG. 2B of DiSanto is used to perform analog to digital conversion when digitized voice data is directed to port 245 (see paragraph [0033] of DiSanto). Thus, the modem 240 is used merely to comply with the technical requirements of a respective network, but does not provide a technical solution enabling encryption of voice data in a heterogeneous network including a packet-oriented network and a TDM network.

Furthermore, claim 11 specifies that "a point-to-point protocol connection is used over the modem connection in transporting the data packets using the encrypted transport protocol, as well as messages of the key exchange protocol." The Examiner alleges that this feature is anticipated by "a procedure for establishing a direct connection between two nodes" disclosed in DiSanto. However, unlike in DiSanto, the modem of the claimed security module enables the data packets from the packet-oriented network to be transported using the encrypted transport protocol, along with messages of the key exchange protocol, via the modem connection. The procedure for establishing a direct connection between two nodes in DiSanto does not anticipate or render obvious this type of connection among terminals of different networks.

The Examiner continually indicates that features of the claimed modem connection unit are intended use features that are not accorded patentable weight. However, this is respectfully submitted to be incorrect. It is respectfully submitted that the Examiner must consider each limitation, even assuming, *arguendo*, that the limitation does not provide any additional structure. As is clear from MPEP §2173.05(g), there is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). "A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used," e.g., a functional limitation may be used to functionally define a particular capability or purpose that is served by the recited element.

In asserting an intended use argument, the prior art structure must be capable of performing the intended use. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Thus, the modem of DiSanto must be enabled to accomplish the claimed functional language of the present invention as set forth in claim 11, for example. Specifically, the modem of DiSanto must be enabled to include setting up a modem connection

between the second telecommunication terminal and at least one of a gateway and another second telecommunication terminal, with the data packets being transported using the encrypted transport protocol, along with messages of the key exchange protocol, via the modem connection, wherein a point-to-point protocol connection is used over the modem connection in transporting the data packets using the encrypted transport protocol, as well as messages of the key exchange protocol.

At least for the above reasons, amended claim 11 and pending claims 14-15, 17, and 20-21 depending from claim 11 patentably distinguish over the prior art.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 9-4-09

By: _____

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